

REMARKS/ARGUMENTS

Claims 1, 2, 4, 5, 9, 10, 19, 20, and 30-39 are pending in the application. The Applicants hereby request further examination and reconsideration of the application in view of these remarks.

Rejections Under 35 U.S.C. 103

In paragraph 3, the Examiner rejected claims 1, 2, 4, 5, and 30-34 under 35 U.S.C. 103(a) as being unpatentable over Borland et al. ("Borland") in view of Young, III ("Young").

In paragraph 4, the Examiner rejected claim 9, 10, 19, 20, and 35-39 under 35 U.S.C. 103(a) as being unpatentable over Borland in view of Young and further in view of Tuoriniemi et al. ("Tuoriniemi").

Claim 1

In the Office Action, the Examiner withdrew the previously pending rejection of claim 1 over Sato in view of Borland and further in view of Tuoriniemi. The Examiner, however, introduced a new rejection of claim 1 as being unpatentable over Borland as the primary reference in view of Young as the secondary reference. The newly presented rejection over Borland in view of Young is similar to a previous rejection of claim 1 over Sato as the primary reference in combination with Borland as the secondary reference and Young as a tertiary reference, which rejection was made in the Office Action dated December 8, 2009. In the Response filed February 4, 2010, the Applicants provided a complete response to this rejection, and, in the Office Action dated March 11, 2010, the Examiner withdrew the rejection over Sato, Borland, and Young and instead introduced a new rejection of claim 1 over Sato in combination with Borland and Tuoriniemi. To the extent that the newly presented rejection over Borland and Young is similar to the previously pending rejection of claim 1 over Sato, Borland, and Young, the Applicants submit that the new rejection of claim 1 over Borland and Young is improper, because it is essentially duplicative of the December 8, 2009 rejection that was previously withdrawn. The Applicants submit that the re-introduction of the rejection of claim 1 over Borland and Young is wholly inconsistent with the Patent Office's objective to conduct "a speedy and just determination of the issues involved in the examination of an application." (MPEP § 904.03.) Because the new rejection is duplicative of the previous rejection that was withdrawn, the re-introduction of the rejection unnecessarily and arbitrarily increases the examination time of the application and places an unjust and unreasonable burden upon the Applicants. The Examiner is therefore estopped from introducing the duplicative rejection, and the rejection should be withdrawn.

Moreover, to the extent that the newly introduced rejection represents a new rejection not previously presented, the Applicants respectfully submit that the newly introduced rejection of claim 1 over Borland and Young is improper and should be withdrawn, because the Examiner has consistently and egregiously failed to comply with the requirements of 37 CFR section 1.104(b) and MPEP section 707.07(g). 37 CFR section 1.104(b), entitled "Completeness of examiner's action," states that "[t]he examiner's action will be complete as to all matters, except that in appropriate circumstances, such as misjoinder of invention, fundamental defects in the application, and the like, the action of the examiner may be limited to such matters before further action is made." (37 CFR § 1.104(b) (emphasis added).) Similarly, MPEP section 707.07(g) states that "Piecemeal examination should be avoided as much as possible. The examiner

ordinarily should reject each claim on all valid grounds available, avoiding, however, undue multiplication of references. (See MPEP § 904.03.)" (MPEP § 707.07(g) (emphasis added).)

Here, the Examiner has been aware of both Borland and Young for over three years — as early as August 20, 2007 — and for three years consistently rejected claim 1 over Sato in combination with Borland and Young, rather than over Borland in combination with Young. In so doing, the Applicants respectfully submit that in each of the five office actions issued since August 20, 2007, the Examiner has repeatedly and egregiously failed to comply with the requirements of 37 CFR § 1.104 and MPEP § 707.07.

The Applicants respectfully submit that by choosing not to present a rejection of claim 1 over Borland as the primary reference and Young as the secondary reference in any of the previous five office actions over the last three years, the Examiner has waived this rejection and is estopped from introducing it at this time. The present rejection of claim 1 is therefore improper and should be withdrawn. For similar reasons, the rejections of claims 2-5 and 30-39 are also improper and should be withdrawn.

In any event, for the following reasons, the Applicants submit that claim 1 is allowable over Borland and in view of Young.

Claim 1 recites "[a] cordless telephone, comprising: a remote handset; a base unit matched to said remote handset; an MPEG audio player integrated within at least one of said remote handset and said base unit; and a summer to digitally sum a digitally synthesized ring tone with an MPEG audio bit stream to allow a user of said cordless telephone to hear said cordless telephone ringing along with music."

The Examiner acknowledged that Borland fails to disclose "a summer adapted to digitally sum a digitally synthesized ring tone with an audio bit stream to allow a user of said cordless telephone to hear said cordless telephone ringing along with music." (Office Action, page 3.) The Examiner alleged, however, that Young teaches this limitation, as follows:

[S]ee column 3, lines 18-21, column 4, lines 27-34, see "the present invention would operate identically with digital or other type telephones," also see Abstract and column 2, lines 9-24, see "a user headset is connected to a mixer with audio input from a Music Source, a mic detecting ambient noise, and a ring tone from the phone", see column 4, lines 24-30, see "so they can hear the telephone rang while listen[ing] to music," also see column 5, lines 50-60, see "a cordless." In addition, column 3, lines 18-19, further teaches that "phone 10 is a standard analog or digital telephone" and column 5, lines 31-34, further teaches that "the present invention would operate identically with digital or other type telephone.) Since the digital telephone 10 of Young is digital, the mixer 22 also a digital mixer, and it reads on Applicants' "digital summing".

(Id. at page 3.) The Applicants again disagree.

The Applicants respectfully submit that the Examiner goes well beyond the teaching of Young, in asserting that Young teaches digitally summing a digital synthesized ring tone with an MP3 audio bit stream. The portions of Young cited by the Examiner simply do not support Examiner's assertion. Young, column 2, lines 9-24, states:

(1) Bypass Mode (handset lifter down, mic position up or down). A Phone is used as a normal telephone that is answered with its handset, and a user headset is connected to a mixer with audio input from a Music Source, a mic detecting ambient noise, and the ring tone from the Phone.

(2) Telephone Mode (handset lifter up, mic position down). The Phone is operated from the headset, the handset is disconnected, and the Music Source is paused.

(3) Music Mode (Handset lifter up, mic position down). The headset is connected to the mixer with audio input from the Music Source, a mic detecting ambient noise, and the ring tone from the Phone. The Phone is disconnected from the phone line, but the Phone may be answered from the headset by entering the Telephone Mode.

(Young, column 2, lines 9-24.) Young, column 3, lines 18-21, states that "[p]hone 10 is a standard analog or digital telephone used access the public switch telephone network. A preferred phone would be headphone-compatible having earphone and microphone level adjustments and electrical compatibilities." (Id., column 3, lines 18-21.) Young, column 4, lines 24-30, states that "in addition, the mixer allows a user to set the music volume as desired, and to control the 'ringing' volume so they can still hear the telephone ring while listening to music. However, to answer the telephone, while operating in the Bypass Mode, the user must lift handset 12 from Phone 10 and operate Phone 10 as a standard telephone." (Id., column 4, lines 24-30.) Young, column 5, lines 30-32, states that "as will be appreciated, the preferred embodiment utilizes an analog phone, but the present invention would operate identically with digital or other type telephones" (Id., column 5, lines 30-32.) And Young, column 5, lines 50-60, states:

In another alternative embodiment, the handset unit 40 is a cordless arrangement using bi-directional infrared links. A base unit would have an infrared transmit/receive tower similar to those used by cordless stereo headphones. The tower would transmit the music/telephone audio signals (ring tone, ambient noise, music, phone audio, etc.) to the cordless headphone set 40. The tower would also receive infrared signals transmitted by the handset representing the audio signals from its microphone, and a coded signal that informs the base unit as to the position of the microphone, as is required to determine the operational Mode.

(Id., column 5, lines 50-60.)

The Applicants do not dispute that the apparatus described in Young (having either a corded or cordless headphone set) may operate with a digital-type telephone. The system of Young comprises a telephone 10, a control box 20, a music source 30, and a headset 40 (which may be corded or cordless). (See Young, column 2, lines 42-49; column 5, lines 50-60; and Figure 1.) Music source 30 and headset 40 are connected directly to control box 20. Only the control box 20 interfaces with telephone 10, through (i) the phone line 27, (ii) the handset lines 15 and 17, and (iii) a lifter signal line 19 that indicates to the control box 20 whether the handset is on-hook or off-hook, based on the operation of a mechanical microswitch for detecting the position of a manually operated handset lifter that is affixed to phone 10. (See id., column 3, lines 31-33, and Figure 1.) As such, the system of Young may operate equally well (indeed, identically) with either an analog telephone or a digital telephone without any modification, because the manually operated handset lifter may be affixed as easily to an analog telephone as to a digital telephone, and because both analog and digital telephones have a phone line port and handset ports that may be connected to the control box.

The Applicants disagree, however, that these cited portions of Young teach a summer adapted to digitally sum a digitally synthesized ring tone with an audio bit stream. Young discloses an analog mixer that inputs an analog ring tone, not a digital synthesized ring tone, as recited by claim 1. The analog mixer receives its inputs from (i) a music source that produces an analog music signal, (ii) a microphone detecting ambient noise, and (iii) a ring signal from the phone line. (See Figs. 1 and 2 and column 4, lines 7-10, stating "A ring signal on the public switched telephone network directed to Phone 10 is detected by Control Box 20, passed through attenuator 24 to provide a Ring Volume, and input to mixer 22.") All three signals that are input into mixer 22 are analog signals. Young provides no teaching or suggestion

whatsoever that the signals input to mixer 22 may be digital signals, or that mixer 22 may be a digital mixer. As such, Young fails to teach or even suggest either digital summing or a digitally synthesized ring tone.

The Applicants further submit that the rejection of claim 1 over Borland in view of Young is improper, because the Examiner failed to identify any sufficient reason to combine Borland with Young to reach the claimed invention. According to the Supreme Court in *KSR Int'l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007), it is "important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements" in the manner claimed (Slip. Op. at 144). Moreover, in her May 3, 2007 Memorandum to Technology Center Directors, Margaret A. Focarino, Deputy Commissioner for Patent Operations, clearly states that "in formulating a rejection under 35 U.S.C. §103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed."

Here, the Examiner asserted that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the teachings of Young into the system of Borland in order to improve in sound headset systems and telephone headset systems." (Office Action, page 3.) The Applicants respectfully submit that the Examiner has failed to explain how or why adding the control box and headset of Young to the cordless telephone of Borland would actually serve to "improve in sound headset systems and telephone headset systems." As such, the Examiner has failed to identify any sufficient reason to combine Borland with Young to reach the claimed invention.

For all these reasons, the Applicants submit that claim 1 is allowable over Borland and Young. For similar reasons, the Applicants submit that claims 9 and 19 are also allowable over the cited references.

Since claims 2, 4, 5, 10, 20, and 30-39 depend directly or indirectly from claim 1, 9, or 19, it is further submitted that those claims are also allowable over the cited references.

The Applicants therefore respectfully submit that the rejections of claims 1, 2, 4, 5, 9, 10, 19, 20, and 30-39 under Section 103 have been overcome.

Claim 30

Claim 30 depends from claim 1 and recites the limitations that "the base unit is adapted (i) to receive from a telephone line a telephone audio signal representing a telephone conversation and (ii) to transmit the telephone audio signal to the remote handset; and the summer is further adapted to digitally sum the telephone audio signal representing the telephone conversation with the MPEG audio bit stream."

The Examiner asserted, inter alia, that Young (at column 2, lines 9-24; column 3, lines 18-21; column 4, lines 27-34; column 5, lines 50-60, and the Abstract) teaches that the summer is further adapted to digitally sum the telephone audio signal representing the telephone conversation with the MPEG audio bit stream. (See Office Action, page 4.) The Applicants respectfully disagree.

The Applicants respectfully submit that the cited portions of Young (quoted above) have no relevance whatsoever to summing a telephone audio signal representing the telephone conversation with an audio stream. Rather, Young teaches that the mixer receives audio input from (i) a music source, (ii) a microphone detecting ambient noise, and (iii) the ring tone from the phone. (See Young, column 2, lines 12-14 and 19-21.) Young further teaches that, in "Telephone Mode", "[t]he phone is operated from the handset, and the handset is disconnected, and the music source is paused." (Young, column 2, lines 15-17

(emphasis added).) Young thus fails to teach or even suggest that “the summer is further adapted to digitally sum the telephone audio signal representing [a] telephone conversation with the MPEG audio bit stream.” Moreover, Young provides no teaching whatsoever that would actually enable a person of ordinary skill in the art to combine a signal representing a telephone conversation with a digital MPEG audio stream.

The Applicants therefore respectfully submit that the above discussion provides additional reasons for the assertions that (i) claim 30 is allowable over the cited references and (ii) for similar reasons, claim 35 is allowable over the cited references.

Since claims 31-34 and 36-39 depend directly or indirectly from claim 30 or 35, it is further submitted that the above discussion provides additional reasons for the assertion that those claims are also allowable over the cited references.

Claim 31

Claim 31 recites the limitations that (i) the telephone audio signal is monaural; (ii) the MPEG audio bit stream has a plurality of stereo channels; and (iii) the summer is adapted to digitally sum the monaural telephone audio signal into each of the plurality of stereo channels of the MPEG audio bit stream, such that a sense of balance in the user is improved.

The Examiner asserted, inter alia, that Young (at column 2, lines 9-24; column 3, lines 18-21; column 4, lines 27-34; column 5, lines 50-60; and the Abstract) teaches that said summer is further adapted to digitally sum the monaural telephone audio signal into each of the plurality of stereo channels of the MPEG audio bit stream. (See Office Action, page 4.) The Applicants respectfully disagree. The cited portions of Young teach or suggest nothing whatsoever regarding summing a monaural telephone audio signal into each of a plurality of stereo channels of an MPEG audio bit stream, such that a sense of balance in the user is improved.

The Applicants therefore respectfully submit that the above discussion provides additional reasons for the assertions that (i) claim 31 is allowable over the cited references and (ii) for similar reasons, claim 36 is allowable over the cited references.

Claim 32

Claim 32 recites the limitation that both the MPEG audio player and the summer are jointly implemented as a single digital signal processor adapted to digitally sum the digitally synthesized ring tone with the MPEG audio bit stream.

The Examiner asserted, inter alia, that Young (at column 2, lines 9-24; column 3, lines 18-21; column 4, lines 27-34; column 5, lines 50-60; and the Abstract) teaches that both said MPEG audio player and said summer are jointly implemented as a single digital signal processor adapted to digitally sum the digitally synthesized ring tone with the MPEG audio bit stream. (See Office Action, pages 4-5.) The Applicants respectfully disagree. The cited portions of Young teach or suggest nothing whatsoever regarding either a digital signal processor or the joint implementation of an MPEG audio player and a summer as a single digital signal processor.

The Applicants therefore respectfully submit that the above discussion provides additional reasons for the assertions that (i) claim 32 is allowable over the cited references and (ii) for similar reasons, claim 37 is allowable over the cited references.

Since claims 33-34 and 38-39 depend directly or indirectly from claim 32 or 37, it is further submitted the above discussion provides additional reasons for the assertion that those claims are also allowable over the cited references.

Conclusion

For the reasons set forth above, the Applicants respectfully submit that the rejections of claims 1, 2, 4, 5, 9, 10, 19, 20, and 30-39 have been overcome.

In view of the above remarks, the Applicants believe that the pending claims are in condition for allowance. Therefore, the Applicants believe that the entire application is in condition for allowance, and early and favorable action is respectfully solicited.

Fees

During the pendency of this application, the Commissioner for Patents is hereby authorized to charge payment of any filing fees for presentation of extra claims under 37 CFR 1.16 and any patent application processing fees under 37 CFR 1.17 or credit any overpayment to Mendelsohn, Drucker, & Associates, P.C. Deposit Account No. 50-0782.

The Commissioner for Patents is hereby authorized to treat any concurrent or future reply, requiring a petition for extension of time under 37 CFR 1.136 for its timely submission, as incorporating a petition for extension of time for the appropriate length of time if not submitted with the reply.

Respectfully submitted,

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